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20 MAR 1997

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In re Application of
SMITH et al
Application No.: 08/392,934
PCT No.: PCT/US93/08699
Int. Filing Date: 15 September 1993
Priority Date: 15 September 1992
Attorney Docket No.: 7586D3033
For: IMMUNOREACTIVE PEPTIDES FROM
EPSTEIN-BARR VIRUS

DECISION ON

RENEWED PETITION

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This is a decision on applicants' "RENEWED PETITION UNDER 37 CFR 1.48(a)" filed in the Patent and Trademark Office (PTO) on 28 October 1996, and applicants' "REQUEST FOR WITHDRAWAL OF NOTIFICATION OF ABANDONMENT" filed in the PTO on 12 December 1996.

BACKGROUND

On 26 December 1995, applicants filed an initial petition under 37 CFR 1.48(a) requesting the addition of a fourth inventor, Dr. Susan Varghese, to the application.

On 23 May 1996, this Office mailed a decision dismissing the petition on the grounds that applicants had not submitted an acceptable statement of facts, an acceptable declaration of the inventors, nor an acceptable written consent of the assignee.

On 28 October 1996, applicants filed the present renewed petition which was accompanied by, inter alia: a petition and fee for a three month extension of time; a verified

statement of facts executed by the three originally named inventors; a declaration of John R. Wetherell in support of the renewed petition; a declaration of the inventors; a copy of an assignment document; and a statement of assent of the assignees.

On 20 November 1996, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT DO/EO/909) indicating that the application was abandoned for failure to respond to the 23 May 1996 decision.

On 12 December 1996, applicants filed the present request which urges that the abandonment of the application should be withdrawn on the grounds that a response to the decision was timely filed.

DISCUSSION

WITHDRAWAL OF ABANDONMENT

A review of the application file reveals that a response to the 23 May 1996 decision was timely filed on 28 October 1996. As such the mailing of the Form PCT DO/EO/909 was in error.

PETITION UNDER 37 CFR 1.48(a)

As set forth in the prior decision, a petition under 37 CFR 1.48(a) must be accompanied by: (1) a statement of fact verified by the original named inventor or inventors establishing when the error, without deceptive intention, was discovered and how it occurred; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63; (3) the fee set forth in 37 CFR 1.17(h); and, (4) the written consent of any assignee. A review of the application file, and specifically the present renewed petition, reveals that applicants have now satisfied items (1)-(3) above.

With regards to item (4) above, a review of the "ASSENT OF ASSIGNEE TO ADDITION TO ORIGINALLY NAMED INVENTORS" reveals that it is not acceptable in that it is not in the form of a verified statement.

Therefore, in that item (4) above still has not been satisfied, the petition may not be properly granted at this time.

CONCLUSION

For the reasons above, applicants' request for withdrawal of the abandonment of the application is GRANTED.

The holding of abandonment is hereby **WITHDRAWN**, and the notification mailed 20 November 1996, is hereby **VACATED**.

Also for the reasons above, the renewed petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.48(a)". No additional petition fee is required.

A proper response must include an acceptable consent of the assignee in the form of a verified statement.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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